REMARKS

I.   Amendments to the Claims

Applicants amend claims 24, 25, 35, 39-41, and 46, and cancel claim 42 without

prejudice or disclaimer of its subject matter. Support for the amendments may be found, for

example, at paragraphs [0016], [0017], [0040], [0083] and [0087] of the Specification. Upon

entry of this Amendment, claims 24-41 and 43-46 are pending and under examination.

II.   Office Action

Applicants respectfully traverse the objections and rejections made in the Office Action,

wherein the Examiner:

- objected to the drawings;

- rejected claims 24 and 26-34 under 35 U.S.C. § 102(e) as being anticipated by

  U.S. Patent No. 7,177,425 ("*Ben*"); and

- rejected to claims 25 and 35-46 under 35 U.S.C. § 103(a) as being unpatentable

  over *Ben* in view of U.S. Patent Application Pub. No. 2004/0204124

  ("*Campbell*").

III.   Response to Objections and Rejections

A.   Objection to the Drawings

The Office Action objected to the drawings because they "do not contain written

description to the steps involved." Office Action, p. 2. In response, Applicants attach four (4)

replacement drawing sheets (containing Figs. 2, 4, 6, and 7), in which descriptive labels have

been added to the boxes corresponding to reference numbers 100-114, 200-214, 300-316, and

400-416 in Figs. 2, 4, 6, and 7. The added labels are supported by the description in Applicants'

specification for each box. Accordingly, Applicants respectfully request withdrawal of the objection.

B.   Claim rejection under 35 U.S.C. § 102(e)

Applicants request reconsideration and withdrawal of the rejection of claims 24 and 26-34 under 35 U.S.C. § 102(e) as being anticipated by *Ben*. In order to establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *See also* M.P.E.P. § 2131. Here, *Ben* does not disclose each and every element of at least independent claim 24.

The Office Action, on pages 3-6, alleges that *Ben* teaches or suggests each and every element of each the above claims. Regarding independent claim 24, *Ben* does not disclose or suggest at least the claimed "storing said **protected data resources** in said **remote database** in an encrypted format **along with said data resources**," as recited in amended claim 24 (emphases added). In fact, the Office Action admits *Ben* does not disclose a remote database. *See* Office Action, p. 6.

Moreover, *Ben* teaches that "[a]fter the encrypted information is generated, the **encrypted information** is stored in the storage module 102, and **replaces** the **information** associated with the subscriber stored in the storage module." *Ben*, col. 3, ll. 44-48. Therefore, *Ben*'s system stores either the information or the encrypted information. It does not store both together at the same time; rather, one replaces the other. Therefore, *Ben* does not disclose at

least the claimed "storing protected data resources ... in an encrypted format along with said data resources," as recited in claim 24.

For at least the reason stated above, *Ben* does <u>not</u> disclose or suggest all of the elements of independent claim 24. Therefore, claim 24 is not anticipated by *Ben* and should be allowable. Dependent claims 26-34 are also not anticipated by *Ben*, and should also allowable at least in view of their dependence from base claim 24. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection.

C.   Claim rejection under 35 U.S.C. § 103(a)

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 25 and 35-46 under 35 U.S.C. § 103(a) as being unpatentable over *Ben* in view of *Campbell*. The Office Action has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. *See* M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In particular, the Office Action has not properly determined the scope and content of the prior art. In addition, the Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because it has not interpreted the prior art and considered <u>*both*</u> the invention <u>*and*</u> the prior art <u>*as a whole*</u>. *See* M.P.E.P. § 2141(II)(B).

Claims 25 and 35-38 depend from claim 24 and therefore, require the recitations of claim 24. *Ben* and *Campbell*, whether taken alone or in combination, fail to teach or suggest each and every element of independent claim 24, nor do they teach claim 24 as a whole.

For example, independent claim 24 recites "storing said **protected data resources** in said **remote database** in an encrypted format **along with said data resources**" (emphases added). The Office Action admits that *Ben* does not teach the above-quoted element. *See* Office Action, p. 6. *Campbell*, however, fails to cure the deficiencies of *Ben*. That is, *Campbell* also fails to disclose or suggest the above-quoted element. The Office Action cites to *Campbell*'s par. [0004] for teaching "a remote server database that allows users of portable or wireless devices to store personal information/file in the database over a network." Office Action, p. 6. However, nowhere in par. [0004], or elsewhere in *Campbell*, is there any disclosure or suggestion of "storing said protected data resources in said remote database in an encrypted format along with said data resources," as recited in claim 24.

Instead, *Campbell*'s par. [0004] discloses "[PIM] identifies those entries that need not be stored in the devices's local memory, and uploads these entries to a remote server database." In *Campbell*, user-selectable entries such as caller ID contacts are initially stored in local memory 15 on the phone 10. *See Campbell*, par. [0014]. If an entry is defined as "permanent," it always resides on local memory 15 and need not be uploaded to the remote server 30. *See Campbell*, par. [0016]. If an entry is defined as "temporary," it is always uploaded to the remote server 30. *See Id.* Therefore, *Campbell* suggests uploading a portion of the data into a remote database and teaches using a local memory for storing the remainder of the data. *Campbell* does <u>not</u> teach or suggest storing all the data together (data resources along with protected data resources in an encrypted form) in a remote database.

Also, the Office Action asserts that "it would have been obvious to one having ordinary skill in the art to allow users to encrypt user's private/personal information and store in a **wireless device** and upload the **desired** encrypted files to remote server database for storage."

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Office Action, p. 6 (emphases added). Even if this assertion is correct, which Applicants do not concede, this is contrary to the claimed invention. Applicants' claimed system/method neither stores information in a wireless device nor uploads only the desired encrypted files. To the contrary, as explained above, Applicants' claimed method/system uses solely a remote database, not a local memory, to upload all of the encrypted files, not limited to the desired ones. *See* Specification, par. [0016]. That is, neither reference, taken alone or in combination, teaches or suggests at least the claimed "storing said **protected data resources** in said **remote database** in an encrypted format **along with said data resources**," as recited in independent claim 24.

In addition, one of ordinary skill in the art would not have found it obvious to modify the system of *Ben* and/or *Campbell*, using teachings of these references, to achieve the required combination recited in claim 24. As noted above, Applicants submit that while examiners may rely upon what is generally known in the art, they *must provide some concrete evidence* in the record in support of findings. Here, Applicants respectfully submit that the Office Action has not explained *why* or *how* one of ordinary skill would have modified the referenced systems, using the teachings of references, alone or in combination, so as to arrive at the claimed invention. For example, the Office Action does not explain, at least: (a) *why* one of ordinary skill would modify the steps of the references so as to store protected information in a remote database in an encrypted format, and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of the references so as to arrive at the above-quoted features of amended claim 24. *See* M.P.E.P. § 2144.

The burden is on the Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would have combined, for example, *Ben* and *Campbell* to arrive at the presently claimed method recited in claim 24. *See* M.P.E.P. § 2144. The Office Action contains

the assertion that modifying *Ben* with the teachings of *Campbell* "provides greater amount of memory space through remote server database." Office Action, p. 6. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications *could* have been performed. However, "[t]he mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). Combining *Ben* and *Campbell* would not result in a predictable variation of Applicants' claimed invention, because a hypothetical combination of any of the references would lack the elements recited in amended claim 24, namely "storing said protected data resources in said remote database in an encrypted format along with said data resources."

Thus, for at least the above reasons, independent claim 24 is not obvious over *Ben* and *Campbell,* whether taken alone or in combination. Claim 24 should therefore be allowable. Dependent claims 25-38 should also be allowable at least by virtue of their respective dependence from base claim 24. Further, independent claim 39, and dependent claims 40-46, which recite similar elements rejected under the same rationale as claims 24-38, should also be allowable for the same reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection.

IV. Conclusion

Applicants respectfully request reconsideration and withdrawal of the objection and rejections, and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein,

Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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